

REMARKS

Claims 1-6 and 8-10 remain in the application. Independent claim 1 has been amended to include the limitations of wherein the abrasive comprises a concentration from about 26 to about 30 percent. Support for this amendment can be found on page 6, paragraph 2 of the present application, for example. No new subject matter has been added with these amendments.

A. 35 U.S.C. § 103(a)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1-6, 8, 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang (Office Action, page 3). The Office contends (to which Applicants do not concede) that Wang teaches a range of periodic acid molarity that would include 0.006 M as in claim 1. However, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). While Applicants do not agree that the periodic acid molarity of Wang is obvious to be about 0.006M, claim 1 has been amended to include the abrasive concentration from about 26 to about 30 percent. Because Wang does not teach or even suggest the limitations of amended claim 1, claim 1 is not rendered obvious by Wang. Because the dependent claims are not obvious for at

least the same reasons as the independent claims from which they depend, the dependent claim rejections will not be addressed at this time. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 1, and claims 2-6, 8, 9 which depend from claim 1, is respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to contact the below-signed Attorney to further the prosecution of the application, the contact number is (480) 715-5488.

Respectfully submitted,

Dated: December 8, 2006

/Kathy Ortiz/
Kathy Ortiz
Reg. No. 54,351
Attorney for Applicants